

3
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Symbio Herborn Group GmbH & Co.	BEFORE THE
Trademark:	SYMBIO LACT and Design	TRADEMARK TRIAL
Serial No:	75-583411	AND
Attorney:	William H. Holt	APPEAL BOARD
Address:	William H. Holt Law Offices of William H. Holt 1423 Powhatan St. #2 Alexandria, VA 22314	ON APPEAL

EXAMINING ATTORNEY'S APPEAL BRIEF

Symbio Herborn Group GmbH & Co. (hereinafter referred to as "applicant") has appealed the trademark examining attorney's final refusal to register the proposed mark, SYMBIO LACT and design. Registration was refused on the Principal Register under Section 2(d) of the Trademark Act of 1946 on the ground that the proposed mark is confusingly similar to the mark, SYMBIO in typed form. The trademark examining attorney respectfully requests that this refusal be affirmed.

FACTS

On November 5, 1998, the applicant filed an application to register the mark, SYMBIO LACT and design for the amended identification of goods of "pharmaceutical and **veterinary** products, namely, biological cultures and media for use in the production of nutritional additives for medical, for veterinary and for sanitary purposes and for the care of health, such nutritional additives consisting of or containing bacterial and/or enzyme preparations; vitamin preparations, roughage and mineral-food supplements; namely, nutritional supplements, vitamins, mineral supplements and nutritional additives for animal and human food; preparations of trace elements for human and animal use, namely, nutritional supplements, nutritional additives containing vitamin preparations and/or roughage and/or mineral food supplements and /or trace elements for medical, for **veterinary**, for sanitary purposes and for the care of the health" in international class 5 on the Principal Register.

In the first office action, mailed July 6, 1999, the examining attorney refused registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 0756724 as to be likely to cause confusion, to cause mistake, or to deceive. The registered mark in U.S. Registration No. 0756724 is SYMBIO in typed form for "Drug [Preparation in Capsule Form] Product for **Veterinary** Use to Combat Infection" in International Class 5.

On January 6, 2000, the applicant submitted a response to the examining attorney's first office action. On September 15, 2000, the examining attorney mailed an office action making final the refusal of registration under Section 2(d) of the Trademark Act. As evidence, the

examining attorney attached third party registrations from X-Search to illustrate that the same marks are used to identify both vitamins and/or nutritional supplements and drugs. On December 20, 2002, applicant filed an appeal brief. The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive.

ISSUE

Whether a likelihood of confusion under Section 2(d) of the Trademark Act exists between the applicant's proposed mark, SYMBIO LACT and design, for "pharmaceutical and veterinary products, namely, biological cultures and media for use in the production of nutritional additives for medical, for veterinary and for sanitary purposes and for the care of health, such nutritional additives consisting of or containing bacterial and/or enzyme preparations; vitamin preparations, roughage and mineral-food supplements; namely, nutritional supplements, vitamins, mineral supplements and nutritional additives for animal and human food; preparations of trace elements for human and animal use, namely, nutritional supplements, nutritional additives containing vitamin preparations and/or roughage and/or mineral food supplements and /or trace elements for medical, for veterinary, for sanitary purposes and for the care of the health" and the registered mark, SYMBIO in typed form, for "Drug [Preparation in Capsule Form] Product for Veterinary Use to Combat Infection."

ARGUMENTS

THE APPLICANT'S PROPOSED MARK, SYMBIO LACT AND DESIGN IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT'S MARK, SYMBIO IN TYPED FORM.

A. Relevant Law Generally

Section 2(d) of the Trademark Act of 1946 [as amended] states:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name

previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. . .

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

B. The Marks SYMBIO LACT and design and SYMBIO in typed form are Confusingly Similar

Consumers are likely to confuse the proposed mark, SYMBIO LACT and design, with the registered mark, SYMBIO in typed form. The examining attorney has considered the applicant's arguments carefully but found them unpersuasive.

The applicant applied to register SYMBIO LACT for "pharmaceutical and veterinary products, namely, biological cultures and media for use in the production of nutritional additives for medical, for veterinary and for sanitary purposes and for the care of health. such nutritional additives consisting of or containing bacterial and/or enzyme preparations; vitamin preparations.

roughage and mineral-food supplements; namely, nutritional supplements, vitamins, mineral supplements and nutritional additives for animal and human food; preparations of trace elements for human and animal use, namely, nutritional supplements, nutritional additives containing vitamin preparations and/or roughage and/or mineral food supplements and /or trace elements for medical, for veterinary, for sanitary purposes and for the care of the health.”

The registered mark is SYMBIO for “drug product for veterinary use of combat infection.”

Applicant’s mark simply adds the term LACT to the dominant term SYMBIO in the registrant’s mark. LACT is descriptive and disclaimed. The mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). - *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (“THE LILLY” and “LILLI ANN”); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’S ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”). Thus, the mere addition of the term LACT to the term SYMBIO is not sufficient to overcome a likelihood of confusion under Section 2(d).

Despite applicant’s assertion that the marks are different, the marks are highly similar in that both marks contain SYMBIO. The examining attorney must look at the marks in their

entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). SYMBIO is clearly the dominant element in both marks. In the proposed mark, the word LACT is descriptive and disclaimed.

While the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

With regard to the design in the proposed mark, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). Thus, the word portion, and not the design portion of the proposed mark will be most likely impressed upon purchasers memory and used by purchasers in calling for the goods.

Applicant states that "it is applicant's contention that the mark SYMBIO is a weak mark in that a considerable number of registrations have been granted for the identical mark and for variations of the word as is granted for the identical mark and for variations of the word." Assuming *arguendo* that the marks were weak, even a weak mark is entitled to protection against

the registration of a similar mark for identical or closely related goods. *In re National Data Corp.*, 222 USPQ 515 (TTAB 1984), *aff'd* 224 USPQ 749 (Fed. Cir. 1985); *Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111 (TTAB 1978); *In re Textron, Inc.*, 180 USPQ 341 (TTAB 1973).

Concerning applicant's reference to other registrations, third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of those marks. *National Aeronautics and Space Administration v. Record Chemical Co.*, 185 USPQ 563 (TTAB 1975).

Applicant states that "it is clear that the differences between applicant's mark SYMBIO LACT (and Leaf Design) and the cited mark SYMBIO, per se, are distinct from each other in all three of the trilogy of sound, appearance and meaning (the term "LACT" being part of applicant's mark, event though disclaimed separate and apart therefrom." When the applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537

(TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP section 1207.01(b).

Applicant also states that "applicant is the owner of U.S. Registration 1,259,060 granted on November 29, 1983, for the word mark SYMBIOFLOR, for comparable goods in International Class 005, the registration being granted to applicant's subsidiary Symbiomed, Inc. (emphasis supplied)." Applicant further states that "applicant's trade name comprises the term SYMBIO, coupled with the term "Herborn", which is the town in Germany of applicant's headquarters" and that "[a]pplicant's company has continued since its founding at Herbron. Germany in 1954." However, applicant should note that the word mark SYMBIOFLOR is a different mark than the proposed mark SYMBIO LACT and design; the proposed mark combines the disclaimed term LACT with the term SYMBIO. Additionally, the identification of goods is different in U.S. Registration No. 1,259,060 for the mark SYMBIOFLOR. Applicant should also note that a trade name is different from a trademark.

C. The Goods are Closely Related

The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Both of the marks are used to identify nutritional supplements and vitamins or drugs. Please see the X-Search evidence previously submitted which illustrates that the same marks identify both vitamins and/or nutritional supplements and drugs. Moreover, both the identification of goods of the registrant and the applicant indicate that the goods are used for veterinary purposes.

The same consumers will be exposed to the goods identified with both of the marks. The similarities among the marks and the goods of the parties are so great as to create a likelihood of confusion. The examining attorney must resolve any doubt as to the issue of likelihood of confusion in favor of the registrant and against the applicant who has a legal duty to select a mark which is totally dissimilar to trademarks already being used. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (TTAB 1979).

CONCLUSION

For the foregoing reasons, the refusal to register on the basis of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d) should be affirmed.

Respectfully submitted,

/Carol Spils/
Carol A. Spils
Trademark Examining Attorney
Law Office 101
(703) 308-9101 Ext. 174

Angela Wilson
Managing Attorney
Law Office 101
(703)308-9101 Ext. 101